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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,411	04/08/2004	Dale W. Malik	190253-1040	7811
38823 7590 03/28/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ BELLSOUTH I.P. CORP 100 GALLERIA PARKWAY SUITE 1750 ATLANTA, GA 30339			EXAMINER FILIPCZYK, MARCIN R	
			ART UNIT 2163	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/820,411	Applicant(s) MALIK, DALE W.	
	Examiner Marc R. Filipczyk	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

This action is responsive to Applicant's response filed on January 29, 2007 wherein claims 1-20 are cancelled and new claims 21-40 are submitted.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claims 21, 28 and 35 do not involve transformation of article or physical object to a different state or thing, they merely recite searching data. Further, independent claims 21, 28 and 35 do not produce a useful, concrete, and tangible result, but

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merely search data to obtain a result so that a score is assigned to the result, however, no data or results are stored for usefulness. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claims 21, 28 and 35 taken as a whole are directed to a mere method and system, i.e., to only its description or expression, an abstract idea, do not comprise a practical application as explained above hence are nonstatutory.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claims 22-27, 29-34 and 36-40 which depend from claims 21, 28 and 35 respectively, are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-25, 30-32 and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As to claims 23-25, 30-32 and 37-39, the limitation of “determine, from the combined score, a potential risk...” was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There are no teachings of or criteria that account for a complete and useful implementation of a combined score to determine any risk.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25, 30-32 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 23-25, 30-32 and 37-39, the phrase “potential risk” is indefinite. The metes and bounds of potential are not clear. There are no teachings of or criteria that account for a complete and useful implementation of a combined score to determine any risk.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Woods (U.S. Patent No. 6,101,491).

Regarding claims 21, 28 and 35, Woods discloses a system, medium method and program comprising (fig. 1 and abstract):

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means for searching for a first piece of sensitive information (fig. 1, items 120, 130 and *query & parameters*);

means for searching for a second piece of sensitive information (figs. 1 and 4, items 130 and 410);

means for obtaining a result for the first piece of sensitive information (fig. 1, items 120, 130, 140 a,b and *hits*);

means for obtaining a result for the second piece of sensitive information (fig. 1, items 120, 130, 140 a,b and *hits*);

means for assigning a first score to the first item of information (figs. 1 and 5, item 530, also see figs. 1 and 4, items 120, 130, 140a,b, 410-440 and *scores*);

means for assigning a second score to the second item of information (figs. 1 and 5, item 530); and,

means for assigning a third score to the sensitive information, the third score being a function of the first score and the second score (fig. 5, items 540, 550 and 560, and col. 9, lines 19-35, *merge hits & scores and results*).

means for providing the third score to a user (fig. 5, items 540, 560 also see figs. 1 and 6).

Regarding claims 22, 29 and 36, Woods discloses sensitive information includes one of: a name, an address, a social security number and telephone number and an email address (see fig. 2, item 250 and related text).

Regarding claims 23-25, 30-32 and 37-39, Woods discloses the combined score can be used for a number of analysis, including potential risks (fig. 6 and col. 6, lines 42-55).

(Note: related query hits and scores are used based on user/client application and potentially include many uses, from security applications to business management)

Regarding claims 26, 27, 33, 34 and 40, Woods discloses the piece of sensitive information is configured to search web pages (col. 6, lines 46-48).

Response to Arguments

Applicant's amendment and remarks submitted on January 29, 2007 have been fully considered but they are not persuasive. All previous claims 1-20 were cancelled and new claims 21-40 are now pending.

Applicant contends that by submitting all new claims and canceling the old claims, the previous rejections are now moot.

Examiner agrees. However, the new claims render new issues and are now rejected accordingly. Please refer to the rejections above.

Applicant contends that the new independent claims are allowable over cited prior art because the cited prior art fails to disclose "combine a first score and a second score".

Examiner disagrees. Woods clearly discloses combining scores for queries by merging the scores (fig. 5, item 540, Woods).

With respect to all the pending claims 21-40, Examiner respectfully traverses Applicant's assertion based on the discussion and rejection cited above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

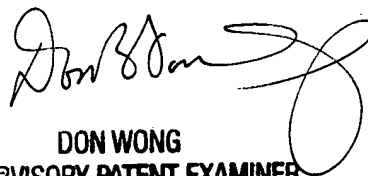
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF
March 22, 2007



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